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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,742	11/28/2000	John S. Hendricks	026880.00021	6312

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ARENT FOX PLLC
1050 CONNECTICUT AVENUE, N.W.
SUITE 400
WASHINGTON, DC 20036

EXAMINER	
GEREZGIHER, YEMANE M	
ART UNIT	**PAPER NUMBER**
2144	

DATE MAILED: 10/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/722,742	HENDRICKS, JOHN S.	
	Examiner	Art Unit	
	Yemane M. Gerezgiher	2144	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *13 July 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-9,11-20,22-29 and 31-33* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-9,11-20,22-29 and 31-33* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *28 November 2000* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. Request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 09/13/2006 has been entered. Claims 1-9, 11-20, 22-29 and 31-33 are now pending in this application.

Response to Arguments

2. Applicant's arguments filed 07/13/2006 have been fully considered but they are not persuasive.

The inventive entity once again (Applicant's Remark on Page 7, ¶3) presents substantially the same arguments previously addressed in the last office action. The inventive entity, now argues that the amended limitation of claims 1, 16 and 24 ("wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller" as been supported by the original specification. The inventive entity points to a statement that read "**it is preferred** that the public viewer be limited to receiving one or two books at a time from the controller" Specification Page 24 lines 14-17.

However, the examiner respectfully disagrees that such a simple statement could be enabling support of the claimed limitation. The statement as recited in the specification (also disclosed above) remains to be no more than a consideration or contemplation of desire, without any specific functional steps showing one or ordinary skill in the art how to make use of the claimed limitation. Barely statement of "preference" is not equivalent to enabling support showing specific steps of the claimed limitation. The cited support of the specification would not have enabled one of ordinary skill in the art to make use of the claimed invention at the time of the invention.

After reconsidering applicant's amendment/remark the examiner note that there is **no functional limitation that prevents the viewer from downloading e-books based on a defined** number of books further including no design of realizing, knowing or identifying how many e-books the viewer actually might have already downloaded. Thus, the examiner maintains his position that there is no written support in the specification that fully supports the alleged functional limitations as recited in the amended claims.

The inventive entity further argues that the cited reference in support of audio/video conversion to text (electronic document) was published after the priority of this application (applicant's remark on Page 10, ¶4).

However, the examiner here presents further evidence of such teachings in the art at the time of the invention (For example see a patent issued to Jackson et al (U.S. Patent Number 5621658, Column 10, Lines 5-7, Column 7,

Lines 19-22, disclosed patent recognizing converting an a media to electronic text).

Applicant's argue that the cited Japanese Patent No. JP405334167A failed to teach deleting stored files after a specific period of time from a client's memory ("automated timeout sequence that erases textual data after a period of time"). The examiner respectfully disagrees with applicant's contention, because the evidence produced clearly taught automatic deletion of data from storage after a predetermined period of time, which satisfies the claimed limitation. Assuming arguendo that applicant's contention is correct, that the teachings of JP405334167A is occurs based on information in the file server computer and not on the device (viewer). The examiner likes to produce the following additional documents in support of the argued limitation:

a. A patent issued in 1977 (Ryan et al. 4,023,408) disclosed, "means to delete data stored in locations identified by said write counter means if said elapsed time exceeds a predetermined period" Column 33, 46-49.

b. Sugiura (U.S. Patent Number 5,146,600) issued in 1992 disclosed, "While the deletion of a document is effected with the control data for the document deleted from the hard disk, any appropriate means may be provided to determine whether a document should be deleted or to **automatically delete a document on confirmation that the document has been saved for a predetermined period of time"**. Column 20, Lines 11-16.

c. Takahashi (U.S. Patent Number 5,565,999) controlling means erases the program information stored in the memory means after elapse of a predetermined time period. Column 8, Lines 39-41.

d. Yamamoto (U.S. Patent Number 5,220,438) "... time-out timer means for determining whether it is the time to erase the storage of the received data, and means for erasing the storage of the received data in the memory when the time-out timer means recognizes that it is the time to release the stored received data" (see Title and Column 2, Lines 13-18).

Thus, the examiner once again note that automatic deletion of an electronic document after a predetermined period of time was well known in the art at the time the invention was made.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-9, 11-20, 22-29 and 31-33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the

specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1, 16 and 24 now recite the following functional limitation:

"wherein the viewer is limited to receiving a determined number of electronic books at a time from the controller"

The inventive entity points to a statement that read "**it is preferred** that the public viewer be limited to receiving one or two books at a time from the controller" Specification Page 24 lines 14-17.

However, such a plain statement could not be enabling support of the claimed limitation. The statement as recited in the specification (also disclosed above) remains to be no more than a consideration or contemplation of desire, without any specific functional steps showing one or ordinary skill in the art how to make use of the claimed limitation. Barely statement of "preference" is not equivalent to enabling support showing specific steps of the claimed limitation. The cited support of the specification would not have enabled one of ordinary skill in the art to make use of the claimed invention at the time of the invention.

Note: The patent law requires that applicant must disclose his invention in such detail that it will not require undue experimentation for one skill in the art. Applicant did not comply this requirement of the first paragraph. The examiner contends (at the time the invention was made) that it would require

undue experimentation for one of ordinary skill in the art of electronic documents to make and use the claimed invention for the reasons set forth in the claims. Applicant is reminded that no new matter is allowed in the amendment to the specifications under 35 U.S.C. 132 and 37 CFR 1.118(a).

Thus, claims 1-9, 11-20, 22-29 and 31-33 are rejected, because the functional limitation disclosed above are not enabled by the original and/or the present specification of the application.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-9, 11-14, 16-20,24, 25 and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) hereinafter referred to as Warnock in view of Tsuchiya (U.S. Patent Number 5,239,665)

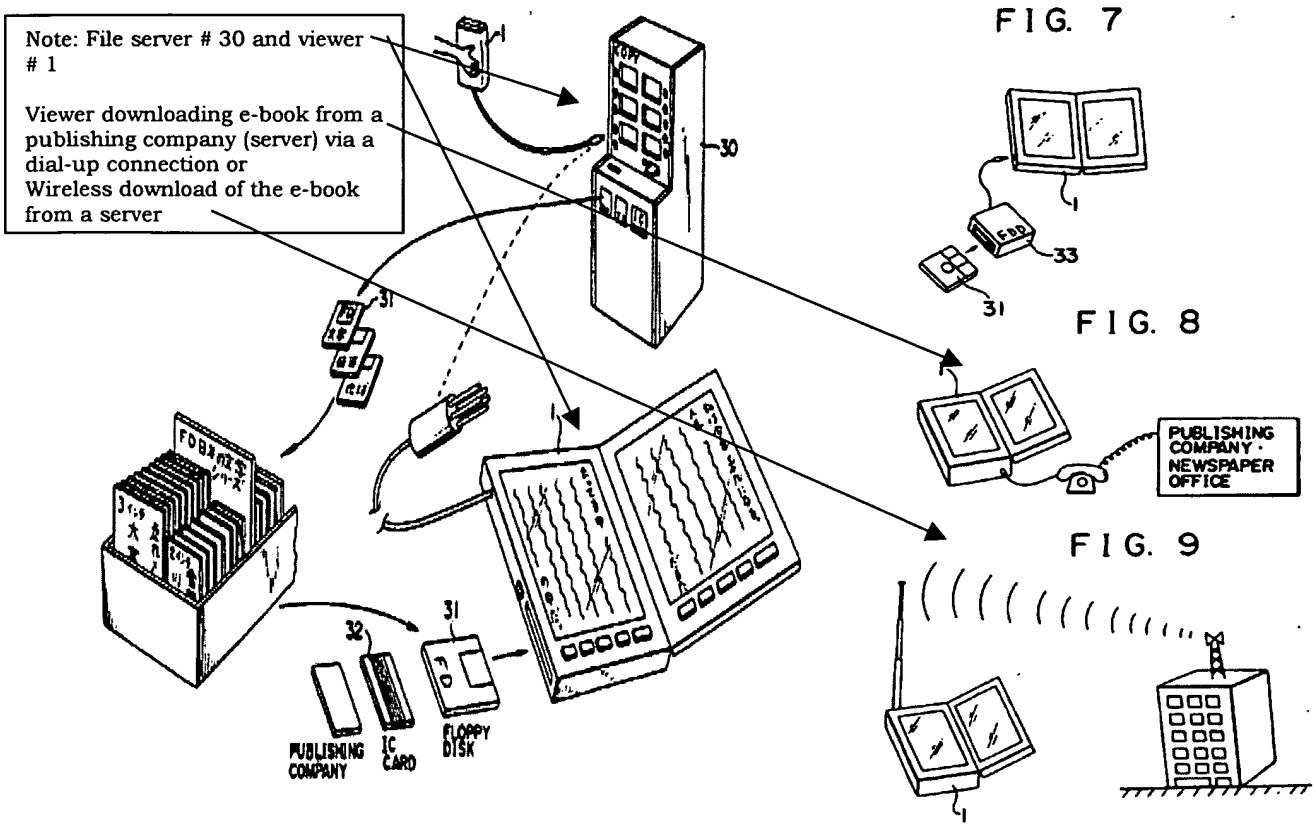
As per claims 1, 16 and 24, Warnock Disclosed formation, delivery and presentation of electronic documents (journals articles and the like) and more particularly to the viewing of electronic documents at the user interface of the

viewer viewing the selected documents (electronic documents selected from the provider and downloaded to a memory of the viewer/client) having therein a selector facilitating selection of desired electronic documents between the server providing the selected document and the viewer requesting the service. See ABSTRACT, Figure 3a, Column 1, Lines 10-20, Column 3, Lines 3-30 and Column 2, Lines 37-59. Warnock disclosed a reader/viewer digital computer system having therein a memory for storing the selected electronic documents (claim 3). See ABSTRACT and Column 14, Lines 49-65. Warnock further disclosed a system directed to digital processing system, the selector/controller having "software for controlling" (stored control programs and scripts) (claim 4) See Column 6, Lines 11-33. Warnock taught a controller having therein a viewing screen controlling the displayed electronic document (claims 6, 7 and 8). See Figures 1, 2 and 3a. Warnock also disclosed a printer connected to the digital computer/server printing electronic documents created and stored therein and printing the selected electronic documents based on displayed titles of the documents displayed for viewing by a client and printing the electronic documents by the printed connected to the system (claims 11-13 and 25). See Column 4, Lines 35-44, Column 5, Lines 47-62, Column 8, Lines 8-20, Column 10, Line 36 through Column 10, Line 17).

Warnock substantially disclosed the invention as claimed. Warnock disclosed a digital machine having therein a selector, a storage or server containing the electronic content and a user interface allowing the viewer to

navigate through the desired electronic document. However, Warnock was silent about the selection of electronic documents in a network (at least two devices connected in some fashion and was silent about renewing or replacing or downloading additional electronic book/document from the file server.

However, as evidenced by Tsuchiya, transmitting electronic documents from server to a client via a third party or a controller or manager was known in the art at the time the invention was made. Tsuchiya disclosed a method of transmitting electronic books from a server ("file server") containing electronic books to an electronic book ("viewer") having therein user interface for displaying the content pages of the selected electronic book and downloading/storing the content on the electronic book on the memory of the client device ("viewer"). Tsuchiya disclosed a viewer accessing a single server which could store limited content of the electronic document/book (claim 9) recited, "Electronic books which are designed to obtain information via a telephone network...Pieces of information may be transferred directly and stored in the inner memory of the electronic book (claims 2, 17, 18, 27 and 28) via telephones and appropriate modems. Later, a reader can have access to a desired piece of information for display." See Figures 6-8 (also disclosed below), Column 6, Lines 7-16 and Column 6, Lines 45-54.



Furthermore, Tsuchiya disclosed a user the viewer bringing the viewer back to the source (file server OR e-library) for additional e-book by means of replacing an external memory mountable to the viewer or remotely connecting the viewer to the source via a telephone network or IR signal to store additional e-book on the server. See Tsuchiya, Abstract, Figs. 6, 8-9, Column 5, Lines 25-67, Column 6, Lines 19-54.

Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Tsuchiya related to transmitting electronic books on the Internet

and the deleting stored documents at the client system in a specified period of time and converting video signal to an electronic signal and have modified the teachings of Warnock related to selecting and viewing electronic documents on a digital computer having therein a viewing display, because such a modification would protect proprietary rights of publishers and authors and allow a reader to have access to electronic documents/books that are remotely located on a server and would facilitate the distribution of electronic books widely (See Warnock, ABSTRACT and Figures 7-9).

3. Claims 15, 22, 23 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Warnock et al. (U.S. Patent Number 5,634,064) in view of Tsuchiya (U.S. Patent Number 5,239,665) further in view of what would have been obvious to one of ordinary skill in the art at the time the invention was made.

With respect to the rejection applied above, the combined teachings of Warnock and Tsuchiya substantially disclosed the invention as claimed. However, failed to teach deleting stored files after a specific periods of time from the viewer's memory and limiting access to file servers and converting video signal to electronic book/document as claimed in this invention. Examiner takes Official Notice (see MPEP § 2144.03) that "deleting stored files after a specific periods of time from the client's memory (claims 22 and 26) limiting access to file servers and controlling the number of electronic

documents that could be downloaded by a client, converting a video signal to electronic document which could be displayed at a client's display (claims 15 and 23)" in a computer networking environment was well known in the art at the time the invention was made. For example, a Japanese Patent No. JP405334167A entitled "NETWORK FILE SYSTEM MANAGING DEVICE" disclosed deleting information stored (downloaded on the client system) at a determined period of time in accordance with information received ("A file deleting part 51 deletes a file included in the client computer in accordance with information stored in a deleting file information storing part 50"). See ABSTRACT. Furthermore, A patent issued in 1977 (Ryan et al. 4,023,408) disclosed, "means to delete data stored in locations identified by said write counter means if said elapsed time exceeds a predetermined period" Column 33, 46-49, Sugiura (U.S. Patent Number 5,146,600) issued in 1992 disclosed, "While the deletion of a document is effected with the control data for the document deleted from the hard disk, any appropriate means may be provided to determine whether a document should be deleted or to **automatically delete a document on confirmation that the document has been saved for a predetermined period of time"**. Column 20, Lines 11-16 and Takahashi (U.S. Patent Number 5,565,999) disclosed "controlling means erases the program information stored in the memory means after elapse of a predetermined time period" (Column 8, Lines 39-41). Another example is Jackson et al (U.S. Patent Number 5621658), Column 10, Lines 5-7, Column 7,

Lines 19-22, which disclosed pattern recognition, and converting a media to electronic text. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03. However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings which were well known in the art at the time the invention was made and have modified the already combined teachings of Tsuchiya related to transmitting electronic books on the Internet and Warnock related to selecting and viewing electronic documents on a digital computer in order to protect proprietary rights of publishers and authors by temporarily allowing clients to store and view electronic contents of interest.

As per claim 32, Tsuchiya disclosed receiving one or two electronic books from the file server # 30 (see Fig. 6, also disclosed above, Column 1, Line 44 through Column 3, Line 67, selected e-book viewer based on the type of storage, storing limited number of electronic documents).

As per claims 31 and 33: The already combined teachings of Tsuchiya and Warnock substantially disclosed the invention as claimed. However, the combined teachings failed to teach a limitation directed to an authorization process to allow access only to authorized viewer. Nevertheless, controlling access to computer resources only to authorized client/viewer via an authorization means was well known in the art at the time the invention was made. See Weiss, Column 10, Lines 5-24. Thus, it is respectfully submitted that it would have been obvious to one of ordinary skill in the art at the time the invention was made to take the teachings of Weiss related to authorization process and have modified the already combined teachings of Tsuchiya and Warnock in order to assure secure access to the information resource (Weiss Column 1, 6-8, 56-57).

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yemane M. Gerezgiher whose telephone number is (571) 272-3927. The examiner can normally be reached on 9:00 AM - 6:00 PM Mon - Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William C. Vaughn can be reached on (571) 272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Yemane M. Gerezgiher
Patent Examiner, Computer Science

WILLIAM VAUGHN
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100